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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,312	08/15/2001	Peter Lind	PHRM-0366	3604

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EXAMINER	
JIANG, DONG	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/930,312	LIND, PETER	
	Examiner	Art Unit	
	Dong Jiang	1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-21,25-29,67-72 and 80*.

   Claim(s) withdrawn from consideration: *23,24,30-66 and 73-79*.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 2. NOTE: the newly amended claims 1 and 80 recite "wherein said polypeptide, ..., stimulates an activity of the polypeptide", which renders the claims indefinite as it is unclear how a polypeptide stimulates itself, and what it is meant by "an activity o the polypeptide". Further, the amended limitation of "98% homologous" in claim 1, and the limitation of "wherein said activity is production of cAPM" in the new claims 81 and 82 raise the new issues that would require substantial further consideration and/or search Furthermore, claims 1-21, 25-29, 67-72 and 80 would remain rejected under 35 USC 101 and 112 first paragraph, for the reasons of records set forth in the previous Office Actions, mailed on 7/17/03 and 2/25/04; and the prior art rejections of claims 1-21, 25-29 67-71 and 80 would be maintained for the reasons of records set forth in those Office Actions. Therefore, the proposed amendment does not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's argument regarding the rejection of the claims under 35 USC 101 and 112 first paragraph, filed on 19 April 2004 has been fully considered, but is not deemed persuasive fo the reasons below. Applicants argue that the claimed receptors share at least 97% sequence homology with two GREAT receptors with known function, thus the utilities asserted are art-established, and that according to the Utility Examination Guidelines, the Office has failed to provide any evidence that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. This argument is not persuasive because as addressed in the previous Office Actions, the utility of a known molecule cannot be automatically applied to a molecule merely based on the sequence homology, and the present application does not disclose any functional property or biological significance specifically associated with the claimed receptor other than that it is a GPCR. As such, it requires further research to identify the functional property of the receptor, and to confirm a "real world" context of use, thus, the asserted utility is not specific nor substantial.